

TC1700 REMSEN

Organization Bldg./Room
U. S. DEPARTMENT OF COMMERCE
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
IF UNDELIVERABLE RETURN IN TEN DAYS
OFFICIAL BUSINESS

AN EQUAL OPPORTUNITY EMPLOYER

U.S. OFFICIAL MAIL
FIRST CLASS PERMIT NO. 1000
PRIVATE USE \$300
UNITED STATES POSTAGE
02 1A \$ 00.60
0004204479 SEP 22 2005
MAILED FROM ZIP CODE 22314

Return to sender

NOT 12FL

UNDELIVERABLE
AS ADDRESSED,
UNABLE TO FORWARD

RECEIVED
NOV 14 2005
USPTO MAIL CENTER



UNITED STATES PATENT AND TRADEMARK OFFICE

1743
T
JW

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,921	06/26/2000	Richard Ameling	GK-GEY-1069	8576

7590 09/22/2005

Gerald H Kiel
McAulay Nissen Goldberg Kiel & Hand
261 Madison Avenue
New York, NY 10016-2391

EXAMINER

NAGPAUL, JYOTI

ART UNIT	PAPER NUMBER
----------	--------------

1743

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
OIPE/IAP

NOV 15 2005

Office Action Summary

Application No.

09/509,921

Applicant(s)

AMELING ET AL.

Examiner

Jyoti Nagpaul

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Amendment filed on April 4, 2000 is acknowledged. Claims 1-4 are canceled.

Claims 5-8 are pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 5-8** are rejected under 35 U.S.C. 102(b) as being anticipated by Stylli (WO 98/52047).

Stylli teaches an automated and integrated system and method for rapidly identifying chemicals with biological activity in liquid samples. Stylli teaches a storage and retrieval module/inter-modular transport system comprising storage location for storing a plurality of chemicals in solution in addressable chemical wells, a chemical well retriever having programmable selection and retrieval having programmable selection and retrieval of the addressable chemical wells and having a storage capacity for at least 100,000 addressable wells. (See pg 4, Lines 4-8) The storage and retrieval module/inter-modular transport system is operably linked to at least on plate buffer that loads and unloads the addressable chemical plates in a predetermined order that is either dependent or independent of the order of selection of the addressable chemical plates. (See pg 13, Lines 21-28) Stylli further teaches a sample transporter/central transport system to transport the selected addressable chemical wells to the sample

Art Unit: 1743

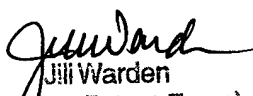
distribution module and optionally having programmable control of transport of the selected addressable chemical wells. (See pg 4, Lines 16-19) Stylli further teaches sample transport means can include conveyer belts, articulated robotic arms, slide mechanisms, automated guided vehicles and the like as known in the art. (See pg 36, Lines 16-19) Stylli further teaches the definition of workflow can be performed by the scientist interface software. A graphical user interface is used to build an assay or other liquid sample process on a computer screen from the various workstations that exist in the system. (See pg 50, Lines 10-12)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Nagpaul whose telephone number is 571-272-1273. The examiner can normally be reached on Monday thru Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill Warden
Supervisory Patent Examiner
Technology Center 1700

LIST OF PRIOR ART CITED BY APPLICANT (Filed on April 4, 2000)

Docket No.: GK-GEY-1069

Applicant(s): Richard AMELING, Thil ENDERLE, Christof FATTINGER, Martin GLUCH and Hansjoerg TSCHIRKY

Serial No.: (Int'l Ph. of PCT/EP99/05542 filed 30JUL99) . Group:

Filed:

Examiner:

U.S. PATENT DOCUMENTS

Exam. Init		Document Number	Date	Name	Class	Sub-Class	Filing Date Appropriate
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						

FOREIGN PATENT DOCUMENTS

		Document Number	Date	Country	CLASS	Sub-Class	Translation YES NO
<i>a</i>	AL	0 809 112	11/26/97	EUROPEAN			
<i>a</i>	AM	WO 97/22882	06/23/97	W I P O			
<i>a</i>	AN	WO 98/26295	06/18/98	W I P O			
<i>a</i>	AO	WO 98/52047	11/19/98	W I P O			
<i>a</i>	AP	0 915 341	05/12/99	EUROPEAN			

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)

<i>a</i>	AS	XP-002122104 / Spektrum der Wissenschaften, Spezial 6: Pharmaforschung, 1997 (pgs 28-35) "Neue Wirkstoffe durch kombinatorische Chemie" M.J. Plunkett, et al.
	AT	
	AU	
	AV	

Examiner: *[Signature]*

Date: 9/16/05

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 509; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.